

This response clarifies that claims 1-49 are pending in the application, with new claims 35-49 being filed with the prior amendment on July 29, 2002.

In the Office Action, the Examiner rejected claims 1-49 under 35 USC § 112, first paragraph. Claims 1-49 were rejected under 35 USC § 102(e) as being anticipated by Beck (U.S. Patent No. 6,332,154). For the reasons set forth below, the applicants respectfully disagree with the Examiner and request that the rejections be withdrawn.

Specifically, in the Office Action, the Examiner rejected claims 1-49 under 35 USC § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." For example, the Examiner stated that the applicants' original specification fails to disclose the "third-party electronic files." Furthermore, the Examiner stated that the use of the term "electronic files" in the amended claims enlarge the scope of the invention, without the requisite disclosure of the supporting technique as to how to converge different formats of "electronic files" into electronic legal documents for processing. The applicants respectfully disagree with these conclusions, and will address each of them in turn below.

A disclosed embodiment of the invention will now be discussed in comparison to the applied references. Of course, the discussion of the disclosed embodiment, and the discussion of the differences between the disclosed embodiment and subject matter described in the applied references, do not define the scope or interpretation of any of the claims. Instead, such discussed differences are intended to merely help the Examiner appreciate important claim distinctions discussed thereafter.

A. Support for the Term "Electronic Files"

As described on page 7, lines 11-19 of the present application, one embodiment of the invention provides legal professionals with access to electronic legal documents, via a network such as the Internet. "These legal documents can include e-mail documents, for example, that are produced in response to discovery requests. . . . Other examples of 'electronic documents' can include electronic calendars/schedules, word-processing files, spreadsheets, text and graphic files, various application files, or any other type of electronic file or data that can be

stored in a computer-readable storage media, and which can be subject to a legal proceeding or need to be otherwise reviewed/accessed.” Therefore, this description makes it very apparent that the term “electronic document” as contemplated by such an embodiment can include any type of data that can be created electronically and stored (usually as some type of electronic file), and which can be subject to a legal proceeding or needs to be processed in some manner.

Figure 3 and the accompanying description of the present application further illustrate how various electronic files may be processed, as part of a proceeding to analyze them as electronic legal documents. For instance, page 16, lines 5-11, identifies such electronic legal documents as “different file types,” which can include Microsoft™ Exchange™ files having a .PST file extension, IBM Lotus Notes™ files having a .NSF file extension, or other types of files including electronic appointment calendars and contact lists, and other types of objects associated with various programs and platforms. Page 16, lines 12-15, further identify other types of electronic files that may be processed by an embodiment of the applicants’ invention and which may be created by different types of software programs, including files having .DOC, .TXT, .RTF, .XLS, .WP5, etc., file extensions. A file having a .DOC file extension may be created using Microsoft Word™, for instance.

The accompanying description of Figure 3 in the present application describes how these files are provided from a source and then placed through various recursive engines and processed by controllers in order to obtain resulting documents that may be reviewed by legal professionals. See, *e.g.*, page 16, lines 20-26, through page 18, line 25. As further supporting disclosure regarding the processing of electronic files, page 19, lines 1-5, of the present application describe how the converter 328 can incorporate a number of software packages or tools to allow it to read, launch, and convert the attachments (*e.g.*, electronic files present in an e-mail attachment). “For example, the converter 328 can use multiple versions of most application programs and/or use various application programs that can read and translate the files created from other types of application programs.” Thus, for an electronic file having a .DOC file extension, the converter 328 can include a version of the Microsoft Word™ application that corresponds to the Microsoft Word™ application program that originally generated that electronic file.

The sections of the present application identified above, which provide the supporting disclosure for the term "electronic files," are just a few examples. A person skilled in the art having read through the applicants' disclosure and having knowledge of the relevant art will readily appreciate that the applicants have provided a description of subject matter in such a way to reasonably convey that the inventors had possession of the claimed invention. Therefore, it is requested that the rejection under 35 USC § 112, first paragraph, as applied to this recitation in the claims, be withdrawn.

B. Support for the Term "Third-party"

On page 6, paragraph 18 of the final Office Action, the Examiner stated that "the third-party communication between Customers A-D or other parties are not disclosed in the original specification," and are considered new matter and rejected under 35 USC § 112, first paragraph. The applicants respectfully disagree with this conclusion by the Examiner. While the applicants' specification does not explicitly use the terms "third-party," it is inherent or explicit in the applicants' disclosure that the electronic files that are processed are third-party in nature.

As summarized in the prior amendment filed on July 29, 2002, embodiments of the applicants' invention may be used in connection with electronic discovery as part of a legal proceeding. Discovery involves a legal process where the attorneys of the opposing parties attempt to collect ("discover") information and other evidence in order to build their case against their opponent. As described on page 2, lines 24-26, through page 3, lines 1-10, of the present application, e-mail is one type of electronic file that is rapidly becoming a rich source of crucial evidence. As explained in this section of the application, individuals are inclined to communicate informally via e-mail, and in one well-publicized court case, previously exchanged internal e-mail correspondence between employees of Microsoft Corporation was reviewed and analyzed by attorneys during the course of discovery in order to build the U.S. government's case against Microsoft. The very nature of discovery makes it clear that the electronic files are third-party in nature. Attorneys are generally never involved (do not participate) in the original correspondence. Rather, the attorneys review the communication that other parties have previously conducted.

Page 8, lines 18-22, and Figure 1 of the present application provide further support that the components, techniques, and processes recited in the claims are applied to electronic files that are third-party in nature. For example, this section of the application describes that the server 112 is specifically dedicated to a particular law firm. This law firm accesses the server 112 in order to perform the various discovery review and processes that are made capable by embodiments of the applicants' invention, with the discovery processing being performed on third-party electronic files that are the subject of discovery during litigation of a case. Again, this section of the application makes it clear that the law firm itself was not involved in the original communication. The law firm becomes involved only after-the-fact, subsequent to the original exchange of the electronic communications and after legal action has commenced, and even then, the attorneys in the firm are still not participating in the e-mail communication threads.

Page 12, lines 1-6, of the present application further describes an administration unit 36. The administration unit 36 can be, for example, a company that provides and maintains the services of the server 112. The assignee of the present application, Applied Discovery, is one such company that can maintain the server 112 for use by law firms during their discovery or other type of legal work that involves electronic review. Such a company, during the course of providing the service to the law firms through the server 112, coordinates data downloads, provides user accounts and passwords for the attorneys, or provides other customer service support. Clearly, the administration unit 36 in conjunction with maintaining and providing the server 112, is not involved in the original generation and communicative exchange of the e-mails (or other electronic files that are being reviewed and analyzed during the course of discovery during litigation of a dispute).

Page 11, lines 15-22, of the present application also provides support that the electronic files are third-party in nature. The information systems 130 that are the source of the electronic legal documents belong to a party (such as Microsoft in the previously described example) who is required by law to "produce all documents" during the course of discovery that are relevant to the case, which can number in the millions of documents. As described in this section of the application, such a party can deliver its information systems data to the requesting lawyers via a download of the electronic files into a storage media 132 (e.g., CDs, DVDs,

magnetic tape, or other mass storage device). Therefore, by the time such electronic files are provided to the conversion engine-134-(operated by Applied Discovery, for example), such electronic files have already been previously generated and stored. There is no longer any active ongoing communication between the parties that originally generated and exchanged these electronic files, and the server 112 having the conversion engine 134 does not interact with the communication. The providing of the electronic files from the party being discovered to the conversion engine 134 is, in effect, a transfer of archived data via physical delivery of storage media (e.g., CDs) or via electronic delivery methods.

Figure 4 of the present application shows an embodiment of a user interface that can display an electronic file, such as an e-mail. As described in the accompanying description on page 21, lines 21-26, the e-mail message 416 of Figure 4 can be typical of electronic legal documents that can be provided in response to a discovery request. In the example of the e-mail illustrated in Figure 4, the e-mail was previously exchanged between Michael W. and Bill P. These, hypothetically, can be individuals within a company (e.g., entity A) or individuals at different entities who are communicating with each other (e.g., between entities A and D). Furthermore, Figure 4 shows the user interface having fields 450 where the reviewing attorney can mark the e-mail as being reviewed, responsive, privileged, hot, and so on. Therefore, it is evident that the reviewing attorney, as well as the services that provide the embodiment of the user interface of Figure 4, was not and cannot be involved in the original e-mail interaction between Michael W. and Bill P. Michael W.'s and Bill P.'s communication via e-mail was third-party in nature relative to the reviewing attorney or Applied Discovery.

C. The Beck Patent

On page 6, paragraph 17, of the final Office Action, the Examiner stated that she disagreed with the applicants' assertion that the prior art on record including Beck, fails to disclose or suggest "the technology to process third-party communication between customers A-D or other parties with which it has no direct interaction." On page 7 of the final Office Action, the Examiner further provided examples from Beck (including the title of the patent) that are alleged to disclose third-party communication between customers A-D with which the company

having the call center of Beck has no direct interaction. The applicants respectfully disagree with this reading of Beck for the reasons set forth below.

First, the title itself of the Beck patent explicitly recites the requirement for interaction with the call center: METHOD AND APPARATUS FOR PROVIDING MEDIA-INDEPENDENT SELF-HELP MODULES WITHIN A MULTIMEDIA COMMUNICATION-CENTER CUSTOMER INTERFACE. (*Emphasis added*). This reference to use of the multimedia call center makes it clear that the customers need to interact with the call center in order to have their needs serviced--it is direct first- and second-party communication between a customer and the call center. The customers cannot bypass the call center and communicate with each other in a manner that can be tracked and processed within the scope of the Beck patent.

Second, the column 4, lines 52-63 section referenced by the Examiner describes the CINOS multimedia communication center of Beck, and in fact supports the applicants' arguments rather than the Examiner's arguments. CINOS is more fully described on column 8, lines 54-67, and elsewhere in Beck, and relates to a customer-interaction network operating system. (*Emphasis added*). Accordingly, it is again evident that the call center of Beck requires interaction between the CINOS call center and customers. Other portions cited by the Examiner on column 4, lines 52-63, further emphasize this point and support the present applicants' arguments. A customer-interfacing window is provided as a COM-based module presented in such a WEB-form or as a CTI application in a COST environment such as may be used in conjunction with an IVR (interactive voice response). (*Emphasis added*). According to Beck, this enables the "enterprise" to keep track of potential and existing customers, and to control selected media options for new customers, existing customers, and business associates. The "enterprise" referred to in this section of Beck refers to a company that hosts the call center of Beck in order to process inquiries from its customers.

This and other sections of Beck provide ample proof that Beck requires customers and other business entities to communicate directly with the call center (*e.g.*, first- and second-party communications), via "customer-interface" options including WEB forms (see, *e.g.*, column 4, lines 55-56), in order to exchange information, which is illustrated in the example of Figure Y that was filed as part of the Remarks with the prior amendment. Beck does not disclose, teach, or suggest a multimedia call center (or any other process, system, device,

method, etc.) that has a capability to process third-party communications between customers A-D with which it has no direct interaction. The customer interaction of Beck has to occur through the multimedia call center in order to have the customer's inquiries intelligently analyzed by the business that hosts the multimedia call center, so as to identify and service the customers' needs. It makes no sense to provide a call center of Beck that processes externally exchanged third-party communications that are unrelated to and do not have interaction with the business.

If the Beck system was to receive an .NSF file containing thousands of third-party emails that have been previously exchanged between customers A-D (and being communicated independent from and external to the call center), the Beck system would not know how to process such an .NSF file to determine who sent what to whom. The call center was never involved in the original communication flow, and so would have no way of determining or tracking the emails that are provided to it via an .NSF file stored on a CD.

Accordingly, claims 1-49 in their current form are allowable under 35 USC § 102(e) over Beck, since they include the recitation of "third-party electronic files" (as well as other limitations that distinguish over Beck). It is believed that no additional amendments need be made to the claims in order to distinguish over Beck and to put the claims in condition for allowance.

D. Information Disclosure Statement Filed on June 4, 2002

An Information Disclosure Statement, form PTO-1449, and copies of the references listed therein were filed with the USPTO on June 4, 2002. The applicants have noted that the Examiner did not acknowledge receipt or consideration of these references in the final Office Action. The IDS and accompanying documents were properly and timely filed along with the appropriate certification. The applicants kindly request the Examiner to return an initialed copy of the form PTO-1449 along with the next communication, to indicate that the references listed therein have been considered. For the convenience of the Examiner, a duplicate copy of that form PTO-1449 is included along with this response.

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above remarks, the

independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

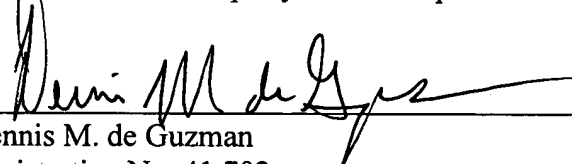
If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.

Formal Drawings are being submitted along with this response. The Commissioner is authorized to charge any additional fees due by way of this response, or credit any overpayment to our Deposit Account No. 19-1090.

Respectfully submitted,

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